

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERBRAND RUSTENBURG

Appeal No. 1997-3684
Application No. 08/468,010

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

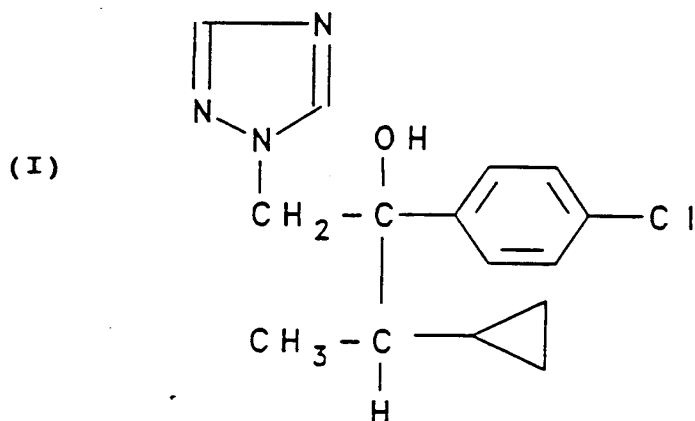
DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-9 and 11-13, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

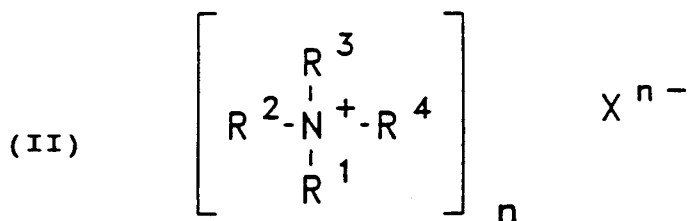
1. A fungicidal composition which comprises

A) cyproconazole of the Formula I



in combination with

B) inorganic or organic ammonium salts of the formula II



in which R^1 - R^4 are identical or different and are an organic substituent which has up to 18 carbon atoms and which is bonded by a carbon-nitrogen bond, or three of the radicals R^1 - R^4 together with the nitrogen atom form a heteroaromatic system, X^{n-} is the anion of an inorganic or organic n-basic acid, and n is 1, 2 or 3.

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The references relied upon by the examiner are:

Schaub	4,664,696	May 12, 1987
Iwasaki et al. (Iwasaki)	4,888,049	Dec. 19, 1989
European Patent Application		
Reinecke et al. (Reinecke) ¹	0,237,764 A3	Sep. 23, 1987

GROUND OF REJECTION

Claims 1-9 and 11-13 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Schaub, Reinecke and Iwasaki.

We reverse.

DISCUSSION

In reaching our decision in this appeal, we considered appellant's specification and claims, in addition to the respective positions articulated by the appellant and the examiner. We make reference to the examiner's Answer² for the examiner's reasoning in support of the rejection. We further reference appellant's Brief³, and appellants' Reply Brief⁴ for the appellants' arguments in favor of patentability. We note that the examiner entered the Reply Brief without comment⁵.

¹ We note that the examiner provided appellant with an English translation of this reference. See Answer, page 2, n. 1.

² Paper No. 10, mailed May 15, 1997.

³ Paper No. 9, received January 21, 1997.

⁴ Paper No. 11, received June 25, 1997.

⁵ Paper No. 12, mailed July 30, 1997.

Appellant then filed a Supplemental Paper⁶, which resulted in a Remand⁷ of the application, from the Board, to the examiner for consideration of the newly submitted material. On November 12, 1998, the examiner sent a communication⁸ to appellant explaining that this Supplemental Paper was not timely filed and therefore was therefore not considered by the examiner. Accordingly, we have not considered this Supplemental Paper in our deliberations.

THE REJECTION UNDER 35 U.S.C. § 103:

Appellant recognizes (Brief, page 7) that “[i]t is beyond dispute that 1) Schaub discloses the fungicide, cyproconazol, 2) Reinecke et al. disclose other fungicides with quarternary ammonium salts; and 3) Iwasaki et al. disclose a non-fungicidal boicide and a branched quarternary ammonium synergist.” However, appellant argues (Brief, page 7) that “no legitimate legal nexus exists to combine those teachings without hindsight.” In response, the examiner, relying on In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CPA 1980), argues (Answer, pages 4-5) that:

The difference between the claimed invention and the cited references is that no single reference expressly discloses the combination of cyproconazole and quaternary ammonium salts, as claimed. However, both ingredients are known fungicides with activity against Basidiomycetes, Ascomycetes and Deuteromycetes, and their combination for fungicidal purpose for a substrate such as wood would have been obvious since such substrate is susceptible to fungi such as Basidiomycetes, Ascomycetes and Deuteromycetes.

⁶ Paper No. 14, received August 21, 1998.

⁷ Paper No. 15, mailed October 29, 1998.

⁸ Paper No. 16, re-mailed on May 26, 1999 (Paper No. 20).

On reflection, we find it unnecessary to pass on the issue of prima facie obviousness. Even assuming arguendo that the examiner established a prima facie case of obviousness, on this record we find that the objective evidence of non-obviousness in the specification (pages 5-6) serves to rebut any such prima facie case.

We remind the examiner that a conclusion of prima facie obviousness, does not end a patentability determination under 35 U.S.C. § 103. As stated in In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986):

If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Here, appellants provide evidence of unexpected results. Specifically, appellants argue (Brief, page 9) that:

The data presented on page 6 of the specification clearly demonstrate that appellant's compositions provide unexpectedly superior fungicidal control at lower levels of the combined active agents than [sic] can be achieved with the active agents applied alone at equal or higher levels than the total combined amount of active agent used in the combination treatment. Such results are indicative of synergism....

Appellant concludes (Brief, page 9) that the observed reductions (~50% for cyproconazole and 95% for dimethyldidecylammonium chloride) in the amount of compound needed as part of the claimed composition as opposed to the use of the compounds alone are substantial and unexpected. However, in response the examiner argues (Brief, page 6) that "appellant's specification results are

incomplete and fail to evince nonobviousness, because it cannot be determined therefrom efficacy which would have been expected, using appellant's experimental design, from the individual components of the invention mixture and their combinations." In particular, the examiner argues (Answer, bridging sentence, pages 5-6) that "at a minimum, without Coniophora or Poria data for ... [cyproconazole] tested by itself at 121 g/m³ and ... [dimethyldidecylammonium chloride] tested by itself at 605 g/m³, appellant's results are meaningless." To this, appellant takes issue (Reply Brief, page 2):

Appellant provides herewith copies of the European Test Standards EN 84 and 113 ... followed by appellant to produce that data [presented in the specification] (specification, page 5). Such protocols were designed and ratified to permit an evaluation of a practical wood protectant (EN 113) and wood preservative (EN 84) effect ("[t]his European Standard specifies a laboratory method of test which gives a basis for the assessment of effectiveness of a wood preservative against wood destroying basidiomycetes" [EN 113, page 4, first paragraph]). Accordingly, appellant finds the Examiner's criticisms of the data set forth in the specification to be inconsequential, ("[w]hen an applicant demonstrates substantially improved results, ... and states that the results are unexpected, this should suffice to establish unexpected results in the absence of evidence to the contrary." In re Soni, 54 F.3d 746, [751] 34 USPQ2d 1684, 1688 (Fed. Cir. 1995)(emphasis in original).

We agree with appellant. We see no reason to question the data without some indication either from the data or from the prior art that these types of tests give unreliable results. See In re Kollman, 595 F.2d 48, 56, n. 8, 201 USPQ 193, 200, n.8 (CCPA 1979). Here, the specification discloses that the tests were performed in accordance with the "European Testing Standards ES 84 (1979) and 113 (1986), as set forth in Kollman, 595 F.2d at 56, n. 8, 201 USPQ at 200, n. 7

"[a]lthough industrial standards are not necessarily determinative of what constitutes an unobvious result, they should go a long way in evincing what one having ordinary skill in the art look at in making a choice between compositions." On this record, we agree with appellants (Reply Brief, page 2) that the examiner failed to meet his burden of providing the evidence necessary to demonstrate that appellant's unexpected results would not be unexpected by one of ordinary skill in the art. Accordingly, appellant is under no obligation to carry out experiments that in the examiners opinion are better without a fact based analysis that appellant's testing is flawed.

Furthermore, we note the examiner's argument (Answer, page 5) that "because Iwasaki suggests synergism, one having ordinary skill in the art would have been further motivated to combine the ingredients of at least claims 1-9 and 12." However, as explained by appellant (Brief, page 9) "[t]he observed ... reductions (~50% and 95%, respectively) are substantial and unexpected." On this record, we find no explanation from the examiner as to why one of ordinary skill in the art would have expected the order of magnitude difference, obtained by appellant, as demonstrated by appellant's results.

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Accordingly, we reverse the examiner's rejection of claims 1-9 and 11-13
under 35 U.S.C. § 103 as being unpatentable over the combination of Schaub,
Reinecke and Iwasaki.

REVERSED

SHERMAN D. WINTERS
Administrative Patent Judge

WILLIAM F. SMITH
Administrative Patent Judge

DONALD E. ADAMS
Administrative Patent Judge

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